



**UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office**

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

CB

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
-----------------	-------------	----------------------	---------------------

09/376,461 08/18/99 RILLIE

D 1128.006A

EXAMINER

PM82/0227

JOHN L ROGITZ ESQ
ROGITZ & ASSOCIATES
750 B STREET
SUITE 3120
SAN DIEGO CA 92101

COHEN, C
ART UNIT

PAPER NUMBER

3634
DATE MAILED:

02/27/01

9

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
ASSISTANT SECRETARY AND COMMISSIONER OF
PATENTS AND TRADEMARKS
Washington, D.C. 20231

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 9

Application Number: 09/376,461
Filing Date: August 18, 1999
Appellant(s): Rillie

MAILED
FEB 27 2001
GROUP 3600

Mr. John Rogitz
For Appellant

EXAMINER'S ANSWER

This is in response to appellant's brief on appeal filed November 30, 2000.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

Art Unit: 3634

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

Claims 10-15 directed to the non-elected method (without traverse) been canceled.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

Appellant's brief includes a statement that claims 1-4 and 6-9 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

Art Unit: 3634

(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

The following is a listing of the prior art of record relied upon in the rejection of claims under appeal.

5,896,713	Chao et al	4-1999
5,655,339	DeBlock et al	8-1997
4,549,379	Hoy et al	10-1958
6,044,592	Strieter	4-2000
5,956,191	Blackmon et al	9-1999

(10) Grounds of Rejection

Claims 1-9 are rejected under 35 U.S.C. 102(e) as being anticipated by Chao et al #5,896,713. Chao et al teach a skylight having a flashing that is a frustoconical shaped curb. A skirt extends from the curb and includes a plurality of surface strengthening ribs that extend radially on the skirt.

Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over DeBlock et al #5,655,339 in view of Hoy et al and Strieter. DeBlock et al teach that it is known in the art to provide a tubular skylight comprising a flashing, a transparent dome, a skylight tube, and a frustoconical shaped curb defining an open top. DeBlock et al do not teach a seamless flashing. Hoy et al teach that it is known in the art to provide a seamless curb member 45 as recited in

Art Unit: 3634

claim 6 of Hoy et al to provide a leak-proof and condensation-proof assembly. For this reason, it would have been obvious to make DeBlock et al as a seamless structure as taught by Hoy et al. DeBlock et al further do not teach a "metal flashing." Strieter teaches that it is known in the art to use a metal in construction of a roof flashing since metal provides superior durability and can be formed into the particular shape of a specific application. For this reason, it would have been obvious to one having ordinary skill in the art, at the time of applicant's invention, to provide DeBlock et al with a metal flashing as taught by Strieter.

Claims 2-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over DeBlock et al. Hoy et al and Strieter as applied to claim 1 above, and further in view of Blackmon et al #5,956,191. DeBlock et al, Hoy et al and Strieter teach the invention as discussed in the rejection above including the teaching of a skirt. Neither reference teaches that it is known to provide a plurality of ribs oriented radially on the skirt. Blackmon et al teaches that it is known to provide a plurality of ribs 40 extending outwardly to fortify the plate member. For this reason, it would have been obvious to one having ordinary skill in the art, at the time of applicants' invention, to provide DeBlock et al with a radially extending reinforcing member as taught by Blackmon et al.

(11) Response to Argument

At the outset, note that the Brief states that claim 1 and claim 6 are the only claims that stand or fall separately (see page 3 of the Brief). Therefore, claims 2-4 and 7-9 will not be separately addressed since these claims stand or fall with claims 1 and 6. The Examiner's Answer addresses arguments regarding the particulars of claims 1 and 6.

Art Unit: 3634

The subject matter of claim 1 differs from that of claim 6 in that claim 1 requires a skylight having a seamless flashing, while claim 6, requires a flashing formed with a surface strengthening anomaly. There is no requirement in claim 1 of an anomaly. Likewise, in claim 6, there is no requirement for the flashing to be seamless. That is, neither independent claim requires *a seamless flashing having an anomaly*. The Brief indicates, in the last paragraph on page 2, that the invention of claim 1 is a seamless metal flashing and that "As set forth in claim 6, it [the seamless flashing] includes a hollow frusto-conical shaped curb....with at least one surface strengthening anomaly." Appellant seems to be implying, by using the term "it", that claim 6 requires both a seamless flashing and an anomaly. Each independent claim requires one or the other feature, not both features simultaneously.

Referring to appellant's brief, paragraph 8, appellant argues that the rejection of claim 1 is improper because Chao et al is not a seamless metal flashing as required by claim 1. Appellant states that Chao et al and the instant invention are commonly owned and that, even though Chao fails to teach a seam anywhere in the disclosure, including the drawings, the flashing of Chao et al is seamless. The examiner refers to appellant's specification on page 2, first paragraph, where appellant admits that making skylight flashings from a generally flat piece of sheet metal formed into the desired frusto-conical shape is conventional. This piece of material is "seamless" and therefore the flashing Chao et al is seamless since there are no seams from one end to the other. Therefore, the broad recitation in claim 1 of "a seamless metal" appears to be anticipated by Chao et al since the sheet metal contains no seams.

Art Unit: 3634

Furthermore, the figures of Chao et al, which are required to contain all of the subject matter of the invention, fail to show a seam. The examiner advanced in the Final Office action that flashing of Chao et al is seamless. However, since the instant application and the patent to Chao et al are commonly owned, appellant affirms that Chao et al invention, although not shown in the figures, contains a seam. As stated above, the examiner is interpreting the flashing of Chao et al as seamless because, from one end of the sheet metal flashing to the other end, no seam is present.

Regarding claim 6 and the welded ends of Chao et al, claim 6 requires a flashing having an anomaly. Claim 6 does not require the flashing to be seamless. The sheet metal of Chao et al is formed into a frusto-conical shape and connected together at the two ends through a weld. This weld constitutes an “anomaly” and the resultant weld is clearly stronger than the surrounding metal. Thus, the weld constitutes a “strengthening anomaly” that is well-within the breadth of claim 6.

Contrary to the allegation made in paragraph (b) of the Brief, the examiner is not interpreting the shading lines as an anomaly. As noted above, the weld is the anomaly and the “anomaly” of claim 6 “reads on” the weld in Chao et al. The law of anticipation is clear that a reference does not need to actually teach what appellant has done. Rather, the law of anticipation merely requires that the claim “read on” something in the reference. The broad recitation of an “anomaly”, “reads on” the weld of Chao et al.

Art Unit: 3634

Appellant argues in paragraph (c) that the proposed combination fails to meet the requirement for a prima facie case of obviousness. Appellant is reminded that three basic criteria are used when establishing a prima facie case of obviousness; stated motivation to combine, a reasonable expectation of success, and a teaching of the claimed limitations.

First, the rejection sets forth a motivation to combine the references (“to provide a leak-proof... assembly” as recited in claim 6 of Hoy et al). Second, there is a reasonable expectation of success. Hoy et al is provided *only* for its teaching of a seamless element in art, not for the teaching of plastic. Therefore, one of ordinary skill would have known, and expected, to have to used the proper metal forming method to form the flange member from a metal sheet. Appellant purports that one of ordinary skill would have had to vacuum molded the metal sheet of DeBlock et al to arrive at a seamless member because Hoy et al teaches the method of vacuum molding. There is a presumption of skill when considering combining the references. One of ordinary skill would have known to use the proper manufacturing technique for the particular material. Note, Hoy et al is *not* cited for teaching a particular method of making the seamless structure. Hoy et al is cited only for the seamless feature. The method in which is was manufactured is inconsequential to the combination. And third, all of the limitation are met by the combination of DeBlock et al, Hoy et al and Strieter.

Appellant argues that the position argued in the Final Office Action, “it is the examiner’s position that the process of stamping a seamless metal member is a well-known expedient in the art”, is improper because this reasoning was not asserted in the Section 103

Art Unit: 3634

rejection. It is the examiner's position that metal stamping is a well-known process of manufacturing a product. This position was set forth in the "Response to Arguments" of Final Office Action merely to clarify and support the combination of references and not to replace the motivation provided in particular rejection. *Note, there is no requirement in the claim for the prior art to teach the same process or method of manufacturing the seamless material.* Furthermore, even if the claim required a particular process, as appellant is aware, patentability is based on the final product made, not the process by which the product is made. It seems as though appellant, who states in the Brief to have extensive experience in the field of skylights, was unaware of the well-known technique of stamping a metal sheet into the desired shape (see arguments on page 5, second paragraph) until conception of the instant invention. Nonetheless, there is no requirement for teaching the process of stamping, the examiner was merely stating that the stamping process is a well-known manufacturing technique. Contrary to the purported allegation on page 5 that the examiner must produce a showing in the prior art of "stamping", the Manual requires the examiner to produce a teaching of the prior art only if the limitation is set forth in the claim.

Regarding the rejection of claim 6, Appellant argues that Blackmon et al is non-analogous art because it is not in appellant's field of endeavor and it is not pertinent to the particular problem with which appellant was concerned. It is the examiner's position that Blackmon et al state on column 5, lines 60-63, that "Additional corner support beams 40 are used for corner support." This recitation satisfies the requirement of "pertinent to the

Art Unit: 3634

particular problem with which appellant was concerned” because appellant’s anomaly is for adding support, or strength, to the flashing, the same reasoning advanced by Blackmon et al.

For the above reasons, it is believed that the rejections should be sustained.

Curtis Cohen
February 26, 2001

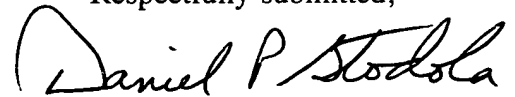
Appeal Conferees:

Daniel Stodola (Supervisory Patent Examiner)
Jerry Redman (Primary Examiner)
Curtis Cohen (Examiner)

Attorney for Appellant:

John L. Rogitz
750 B Street, Suite 3120
San Diego, CA 92101

Respectfully submitted,



**DANIEL P. STODOLA
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600**